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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,190

08/11/2005

Stig Holm

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30593

7590

04/29/2010

HARNESS, DICKEY & PIERCE, P.L.C.

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EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1657

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,190	<b>Applicant(s)</b> HOLM ET AL.	
	<b>Examiner</b> Kailash C. Srivastava	<b>Art Unit</b> 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/11/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/14/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. The response and remarks filed 14 January 2010 to the Office Action with Non-Final Rejection mailed 15 October 2009 is acknowledged and entered.

### **Claims Status**

2. Claims 1-14 are pending.
3. Claims 1-11 have currently been amended.
4. Claims 11-14 have currently been withdrawn.
5. Claims 1-10 are currently under examination and are examined on merits.

This application contains claim 11-14 drawn to an invention non-elected with traverse in the reply filed on 02 November 2007 to Office Action mailed 09 October 2007. A complete reply to the instant final rejection must include cancellation of nonelected claims or other appropriate action (37 C.F.R. §1.144) See M.P.E.P. §821

### **Withdrawn Objections/ Rejections**

6. Considering the amendments and remarks filed 14 January 2010, Examiner withdraws the following objection and rejection in the Office Action mailed 15 October 2009:
  - Objection to Claims; and
  - Indefiniteness rejection to Claims 4-5 under 35 U.S.C. §112, 2nd paragraph.

### **Information Disclosure Statement**

7. Information Disclosure Statement filed 14 January 2010 is acknowledged, has been made of record, has been considered and duly initialed PTO FORMS 1449 or equivalent are enclosed with the instant Office Action.

### **Claim Objection**

8. In consideration of Applicants' amendment filed 14 January 2010, following is a new objection to Claim 4.

As currently presented, Claim 4 does not clearly define at what stage the grinding takes place. Appropriate correction/explanation is required.

### **Double Patenting**

9. In consideration of the USPTO records indicating that the previously co-pending U.S. Non-Provisional application 10/524,192 has been abandoned on 10 February 2010, provisional rejection of Claims 1-10 under the judicially created doctrine of obviousness-type double patenting is herewith withdrawn.

### **Claim Rejections - 35 U.S.C. §103(a)**

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

12. Claims 1-10 remain rejected under 35 U.S.C. §103(a) as obvious over the combined teachings from Kanai, et al (1983, U.S. Patent 4,386,159; IDS filed 02/11/2005) in view of Zhang et al. (US PGPB 20020102673), and further in view of Fischer et al (U.S. Patent 4,252,901).

In response to above-stated rejection in the Office Action mailed 15 October 2009, Applicants respond that Kanai et al., in view of Zhang et al., and further in view of Fisher et al., either alone or in combination do not render Claims 1-10 obvious under 35 U.S.C. §103(a) (Remarks filed 14 January 2010, Page 10, Lines 20-24).

First of all, Kanai et al., clearly describe that "the organic material is finely ground to an average particle size of < 3 mm (Abstract, Lines 2- 3) and further describe that said organic

matter was mixed with “sludge containing bacteria (Abstract, Lines 3-4). Thus, Kanai et al., describe the finely ground organic material and an additional organic material (i.e., sludge). Kanai et al. are silent regarding the dry solid content of the organic matter in range of at least 50% to 70%. However, it will be obvious to an artisan of skill to adjust the weight of solids in the instantly claimed range of at least 50% to 70% in view of Kanai et al's teachings because the result effective adjustment of said and other working conditions is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Regarding drying the organic matter to at least 50% by weight total solids:

- (i) At total weight solids of at least 50%, technically it is not possible to palletize said organic matter, unless Applicants are only referring to particle formation, which is not same as forming pellets.
- (ii) Olsen et al., are silent regarding the grinding of the organic material to at least 50% total solids. Silence, however, does not preclude obviousness. Furthermore, drying of a particular material is for the convenience of transporting said material. The drying step does not materially change the composition /functionality of said material. Furthermore, drying a material to transport said material prior to re-hydrating said material to make a slurry for the subsequent step is only a matter of arbitrary design choice and a step that is merely deemed a matter of judicious design selection of a result-effective parameter which is well within the purview of the skilled artisan and therefore obvious under 35 U.S.C. §103(a).

Furthermore, Fischer et al., teach a method of anaerobically producing methane from “any feed material containing suitable organic material (Column 3, Lines 3-6) including whole. Screened, or dried offal and further teach that said materials can comprise wastes from the farming and food products industries, various plants (e.g., grasses and grains) and animal husbandry (Column 3, Lines 6-22). Thus, it will be obvious to an artisan of skill at the time the claimed invention was made to modify Kanai et al's method by substituting grain or any of the materials that Fischer et al teach; because Kanai et al., teach that a variety of organic materials may be used for methane production and further because the skilled artisan would recognize that Fischer et al., teach that grains for example are art-recognized effective starting sources/ feed for the same purpose, i.e., methane production involving slurries ((*In re Kerkhoven*, 626

F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted)) and See, e.g., M.P.E.P. §2144.06).

Please note further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art at the time the invention was made. See, *In re Keller* 642. F. 2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, the 35 U.S.C. §103 statute does not require that the prior art identically disclose or describe Applicants' invention but rather that no patent should be obtained if the subject matter as a whole would have been obvious to persons having ordinary skill in this art at the time the invention was made.

In response to applicants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, those reasons are cited, e.g., at pages 6-8, items 18-20 of the Office Action mailed 15 October 2009 and for the additional reasons as discussed *supra*. Furthermore, a rejection under 35 U.S.C. §103 (a) based upon the combination of references is not deficient solely because the references are combined based upon a reason or technical consideration which is different from that which resulted in the claimed invention (*Ex parte Raychem Corp*, 17 U.S.P.Q. 2d 1417).

In response to applicants' arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants' arguments cited *supra* have been fully and carefully considered, but are not persuasive for the reasons of record at pages 6-8, items 18-20 of the Office Action mailed 15 October 2009 and for the additional reasons as discussed and explained in the preceding

paragraphs. Therefore, rejection of Claims 1-10 under 35 U.S.C. §103(a) as obvious and unpatentable over the combined teachings from Kanai et al., in view of Zhang et al., and further in view of Fisher et al., in the Office Action mailed 15 October 2009 is maintained and adhered to.

### **Conclusion**

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. No Claims are allowed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:00 A.M. to 5:30 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have

questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kailash C Srivastava/  
Examiner, Art Unit 1657

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23 April 2010

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